

**PATENTS****UNITED STATES PATENT AND TRADEMARK OFFICE**

<b>Application:</b>	10/815,356	<b>Examiner:</b>	YABUT, DIANE D
<b>Confirmation:</b>	8274	<b>Art Unit:</b>	3734
<b>Filed:</b>	03-31-2004	<b>Atty Ref.:</b>	END5008USCIP2
<b>Inventor:</b>	Mark Zeiner		
<b>Title:</b>	Trocar seal assembly		

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

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Applicants request review of the last rejection in the above-identified application. This request is being filed with a notice of appeal. The review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

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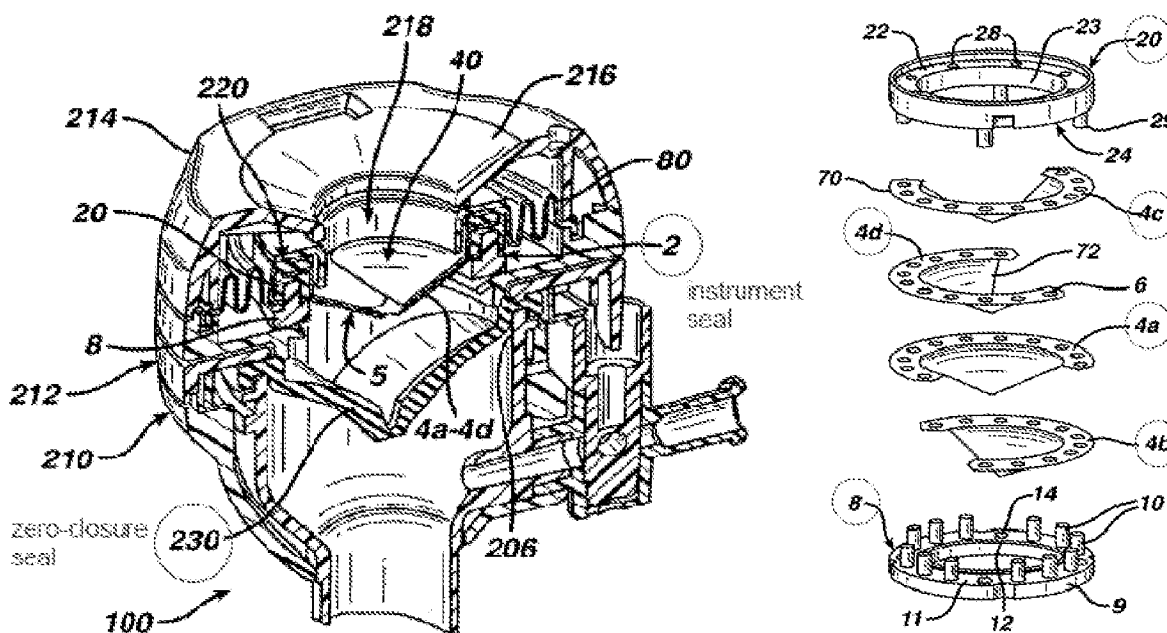
## ARGUMENTS IN SUPPORT FOR PRE-APPEAL BRIEF REVIEW

This application is currently under final rejection. Applicants believe the rejections are improper and have requested this pre-appeal brief review of the last rejection to avoid the time and expense associated with a full appeal.

### I. Introduction

Trocars are used to prevent the escape of fluid or gas during endoscopic surgical procedures. Trocars typically have two distinct types of seals: (i) a zero-closure seal intended seal the trocar when there is not an instrument passing therethrough, and (ii) an instrument seal intended to seal the trocar as instruments are passed therethrough. Central to this pre-appeal is the difference between these two distinct types of trocar seals.

The present claims are directed a novel instrument seal. One embodiment of the claimed invention is depicted in Figs. 7 and 2, portions of which are reproduced below with notations:



As shown in this embodiment, the instrument seal (2) is proximal of the zero-closure seal (230). The instrument seal (2) shown in the exploded view comprises a first substantially rigid ring (8) and a second substantially rigid ring (20). A plurality of separate semicircular seal segments (4a-

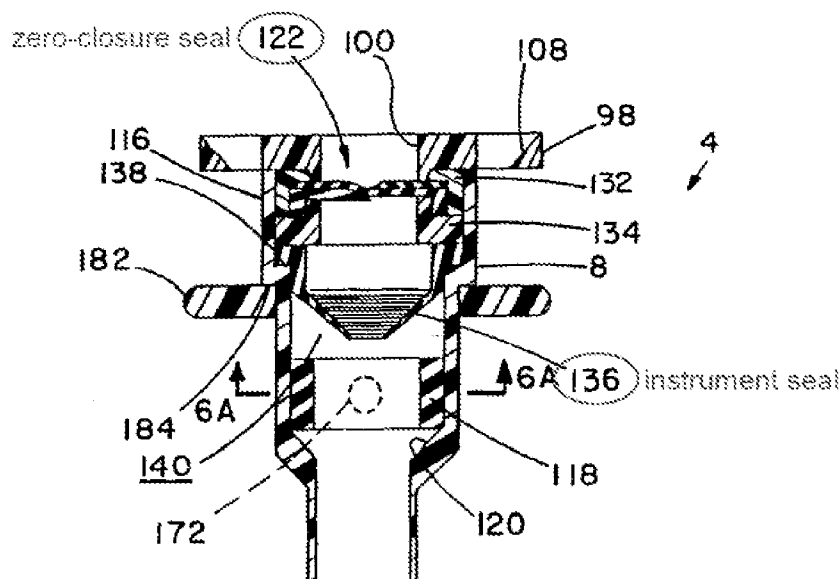
4d) are compressed between the rings (8, 20). Each seal segment (4a-4d) has a circumference greater than 180 degrees.

## **II. Claims on Pre-Appeal Review**

Claims 1-6, 8-11, 17, 19, 23 and 24 are pending in this application; however, for the purposes of this pre-appeal review the Applicants request the panel focus only the independent claim 1.

## **III. Argument**

The final office action dated 03/15/2010 (“FOA”) rejected claim 1 under 35 U.S.C. 103(a) as being unpatentable over Haber et al. (U.S. Patent No. 5,385,552) in view of Honkanen et al. (U.S. Patent No. 4,655,752). This rejection is premised on an erroneous reading of Haber as the primary reference. A portion of Fig. 4 illustrating the seal structure of Haber is reproduced below with notations:



Like most trocars, Haber has two seals: a proximal seal (122) and a distal seal (136). The proximal seal (122) is intended to seal the trocar when an instrument is not positioned in the path (Haber at 2:28-30, 6:1-2, 7:39-42, 8:21-22, abstract). The proximal seal (122) would be referred to in the art as a “zero-closure seal”. In contrast, the distal seal (136) is conical and intended to seal against surgical instruments when they are positioned in the trocar (Id. at 2:17-21, 6:34-37,

7:46-48, abstract). The distal seal (136) would be referred to in the art as an “instrument seal”. Accordingly, Haber has a proximal zero-closure seal (122) and a distal instrument seal (136).

The fundamental error of the rejection arises from comparing Haber’s proximal zero-closure seal (122) to the instrument seal recited in claims. (FOA at 2). In particular, claim 1 current states:

an instrument seal assembly disposed within said housing comprising a first substantially rigid ring, a second substantially rigid ring, and a plurality of separate semicircular seal segments compressed therebetween, each seal segment having a circumference greater than 180 degrees and being adapted to sufficiently seal against instruments positioned through the seal to maintain gas pressure in the abdominal cavity during endoscopic surgical procedures

In contrast to the claimed instrument seal, the proximal zero-closure seal (122) of Haber is not an instrument seal. Indeed, Haber makes clear that the proximal seal (122) intended to seal the trocar when an instrument is not positioned in the path. The FOA even acknowledges that Haber does not teach or suggest all the limitations of the claimed instrument seal:

Haber et al. do not expressly disclose each seal segment 126 being gas-tight or sufficiently sealing against instruments positioned through the seal to maintain gas pressure in the abdominal cavity during endoscopic surgical procedures, however discloses having good sealing qualities (col. 2, lines 11-44).

(FOA at 3, emphasis added). Applicants agree with the Examiner because, as discussed above, the proximal zero-closure seal (122) provides good sealing qualities “when an object is not positioned along the path.” (Haber at 2:29-30, emphasis added). The FOA fails to cite to any teaching or suggestion in Haber that its proximal zero-closure seal (122) could be converted into an instrument seal. Instead, rejection pivots on the following unsupported conclusion:

It would have occurred to one of ordinary skill in the art to form a seal tight enough to further prevent fluid from escaping out the top end of the cannula whether an instrument is present in the cannula or not in order to protect the abdominal cavity.

FOA at 3 (emphasis added). Applicants strenuously disagree because Haber teaches the very opposite. Haber makes clear that the proximal zero-closure seal (122) is not designed to seal against instruments. (Haber at 2:28-30, 6:1-2, 7:39-42, 8:21-22, abstract). Instead, Haber uses a separate instrument seal (136) to seal against surgical instruments. (Id. at 2:28-30, 6:1-2, 7:39-42,

8:21-22, abstract). As such, Haber actually teaches away from modifying the proximal zero-closure seal (122) to additionally seal against instruments because, just like most trocars, that function is already handled by the separate distal instrument seal (136).

Moreover, the conclusion reached in the FOA would improperly modify the principle operation of the Haber. MPEP 2143.01(VI). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As discussed above, Haber makes clear that the proximal zero-closure seal (122) is not designed to seal against instruments. Nevertheless, the rejection is improperly premised on modifying the function of the proximal zero-closure seal (122) and converting it into the very opposite - an instrument seal.

Because the rejection is improperly premised on comparing Haber's proximal zero-closure seal (122) with the currently claimed instrument seal, the rejection of claim 1 is in error.

#### **IV. Conclusion**

Based on the foregoing, the rejection to claim 1 is improper, and Applicants request the panel to find the application is allowed and prosecution remain closed. While Applicants have traversed the rejections on certain grounds, the Office should appreciate the claims may be patentable on other grounds not specifically addressed in this paper. Nothing herein shall diminish or preclude other reasons the claims are patentable, and Applicants reserve all rights and arguments under the law.

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